

### **REMARKS**

The Office Action dated January 11, 2006 has been fully considered by the Applicant.

Claims 1, 5, 7, 13 and 14 are currently amended to further clarify the invention. No new matter has been added to the claims. Claims 2-4, 6, 8, 9, 11, and 12 have been previously presented. Claim 10 has been canceled.

Claim 13 has been rejected under 35 USC 102(b) as being anticipated by United States Patent No. 5,585,858 for Harper et al.

Claim 13 has been currently amended to further clarify that the user of Applicant's broadcast data receiver can select to combine audio or video from a first channel from a first tuner with the audio or video from a second channel from a second tuner to provide a single customized merged video and audio output. Clearly Applicant's teaching of combining data from two tuners to provide a single customized merged video and audio output is not taught or suggested in the Harper et al '858 patent and, therefore, Applicant believes currently amended claim 13 is novel over the '858 patent.

Claim 14 has been rejected under 35 USC 102(b) as being anticipated by United States Patent No. 5,990,927 to Hendricks et al.

Claim 14 has been currently amended to further clarify that Applicant's program guide facilitates a user's selection of independently controllable tuners in a broadcast data receiver to allow merging of data transmissions relating to different channels or user selection to provide a customized merged data output. In contrast, the '927 patent merely displays two programs on the screen at one time and does not provide, as in Applicant's invention, a customized merge data output from different tuners. Clearly, Applicant's invention is novel over the '929 Hendricks et al patent and, therefore, Applicant respectfully requests reconsideration of the rejection.

Claims 1-6, 9, 11-12 have been rejected under 35 USC 103(a) as being unpatentable over United States Patent No. 5,585,858 to Harper et al in view of United States Publication No. 2004/0139465 to Matthews, III et al

Independent claim 1 has been currently amended to clarify that Applicant's broadcast data receiver is arranged to replace at least one elementary stream of a first transmission with at least one elementary stream of a second transmission to provide a single customized merged data output. Clearly this feature is not found or suggested in the cited references. Therefore, Applicant respectfully requests reconsideration of the rejection. Reference to the elementary stream can be found on page 5 of Applicant's specification with reference to Figure 1.

Neither cited reference discloses or suggests that an elementary stream of one transmission can be replaced by an elementary stream of another transmission, as in Applicant's currently amended claim 1. The '858 Harper et al patent and the Matthews et al 0139465 publication merely disclose that both transmissions are output simultaneously such that a user views both transmissions at once. Therefore, the cited prior art documents taken alone or in combination fail to disclose that elementary streams can be selectively replaced by a user. In addition, neither reference discloses the advantages that are attributed to such functionality as described in Applicant's application.

Examiner Hossain has indicated that the Harper et al '858 patent discloses that the user can select data transmitted from the second tuner to provide a program to suit viewer selections. However, in the '858 Harper et al patent interactivity is enhanced through an application of trigger points scattered at various predetermined times through the program. These trigger points correspond to times when interactive events are scheduled to take place. The user of Applicant's

invention is not restricted by any trigger points or to corresponding trigger times when interaction can take place. The user of Applicant's invention can utilize an electronic program guide at any time to select to combine a first data transmission with a second data transmission and the broadcast data receiver replaces at least one elementary stream of a first transmission with at least one elementary stream of a second transmission to create a single customized merged data output which comprises elementary streams from each of the data transmission.

In addition, in the Harper et al '858 patent the viewer selections in response to displayed graphical interrogatory message are preferably made during a period at the onset of the program or when a viewer first tunes into the program. These viewer selections are then utilized as inputs to macros called up at later times during the program by the controller upon the occurrence of the trigger points, identified to the interactive program box by unique codes embedded in the video signal. (See col 6, lines 1-9). It can be easily seen that the viewer selection in the Harper et al '858 patent is restricted to trigger points which can be activated at certain times and to responses to messages made during a period at the onset of the program. No such restrictions are enforced upon the user in Applicant's invention.

Examiner Hossain has indicated that the Matthews et al publication discloses an EPG that a user can select data transmission to provide a customized merged data output or complementary content can be displayed in addition to the program itself as in Applicant's invention. Applicant respectfully disagrees. In the Matthews et al publication, the electronic program guide allows access to hyperlink content relating to programs and makes use of the Windows operating system. The electronic program guide in the Matthews et al publication would simply result in the display of multiple windows on the screen at any given time. The Matthews et al publication teaches away

from Applicant's invention that allows a user by making selections from the electronic program guide to create a single customized merged data output comprised of at least one elementary stream from a first transmission and at least one elementary stream from a second transmission each of which were replaced by the broadcast data receiver.

It is not understood how a person skilled in the art would consider combining a restrictive interactive application with trigger points which correspond to a certain time when such interactive events could take place and having further restrictions of the selections being restricted by input made at the start of a program with an electronic program guide that utilizes a Windows operating system that would merely create multiple windows on a screen to solve the problem of providing a user with a means to create a single customized merged data output as in Applicant's invention. In Applicant's invention a viewer can create a customized audio and video output for a particular football game. For instance, the audio can be the voice of a colorful radio announcer broadcast from a radio station (first data transmission from a first tuner) combined and merged with the play-by-play video from a broadcaster (second data transmission from a second tuner). The broadcast data receiver in Applicant's invention strips away the audio from the play-by-play broadcast and replaces it with the audio of the viewer's favorite colorful radio announcer. There is simply nothing taught or suggested in either the '858 Harper patent or the Matthews publication to contemplate the creativity allowed to the users of Applicant's invention. Therefore, Applicant sincerely believes the currently amended claims are novel over the cited references and respectfully requests reconsideration of the rejection.

It is improper to combine references to achieve the invention under consideration unless there is some incentive or suggestion in the references to do so.

The Court of Appeals for the Federal Circuit has repeatedly held that under Section 103, teachings from various references can be combined only if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F2d 1572, 221 USPQ 929 (CAFC 1984).

Stated another way:

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps...The references themselves must provide some teaching whereby the applicant's combination would have been obvious. In re Gorman, 18 USPQ2d 1885 (CAFC 1991).

In the present invention, there is no suggestion in the references to combine the teachings of United States Patent No.5,585,858 to Harper et al with United States Publication Document No. 2004/0139465 to Matthews, III et al. The Examiner is required to follow the law as set forth by the Federal Circuit. In summary, the combination of patents to achieve the claims of the present invention is untenable.

Claims 7 and 8 have been rejected under 35 USC 103(a) as being unpatentable over United States Patent No. 5,585,858 to Harper et al in view of Matthews and further in view of United States Patent No. 6,784,945 Norsworthy et al. Claims 7 and 8 depend upon currently amended claim 1 and, therefore, Applicant believes claims 7 and 8 are novel over the cited references as previously stated herein with reference to claim 1.

In summary, Applicant's invention provides a creative means for a user to produce a single customized merged data output by selecting from a program guide options to combine a first data transmission having at least one elementary stream from a first tuner with a second data transmission

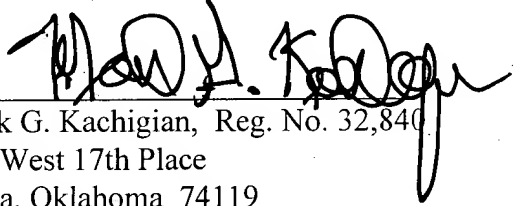
having at least one elementary stream from the least one second tuner. The broadcast data receiver of Applicant's invention is arranged to replace at least one elementary stream of the first transmission with the at least one elementary stream of the second transmission to provide the desired customized merged data output. Clearly these features are not taught or suggestion in the cited references. Applicant sincerely requests reconsideration of the rejections

It is believed that the application is now in condition for allowance and such action is earnestly solicited. If any further issues remain, a telephone conference with the Examiner is requested. If any further fees are associated with this action, please charge Deposit Account No. 08-1500.

Respectfully Submitted

HEAD, JOHNSON & KACHIGIAN

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BY:   
Mark G. Kachigian, Reg. No. 32,840  
228 West 17th Place  
Tulsa, Oklahoma 74119  
(918) 587-2000  
Attorneys for Applicant